

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Maier, et al.

Serial No. : 10/563,539

Filed : December 20, 2005

For : FLUORINE-MODIFIED POLYURETHANE RESINS  
CONTAINING ONE OR TWO CONSTITUENTS, METHOD  
FOR THE PRODUCTION THEREOF, AND USE OF THE  
SAME

Art Unit : 4131

Examiner : M. L. Leonard

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February 13, 2009

This correspondence is being filed electronically addressed to: Commissioner for  
Patents, P. O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

*Eileen Sheffield*  
Eileen Sheffield Date: 2/13/09

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO RESTRICTION REQUIREMENT**

Sir:

Responsive to the restriction's requirement mailed December 30, 2008, please grant the accompanying petition for a one month extension of time. Applicants elect to prosecute the claims of Group III concerning claims 60-69, and, furthermore, species (I), with traverse.

Claims 60-69 are believed to read on the elected species.

The Examiner's objection was based on the statement that no common inventive concept is present between Groups I-III since a correspondingly generic claim is not allowable due to US

Patent 5,189,135 (the '135 patent). However, the '135 patent discloses a fluorinated polyurethane which is obtained by the reaction of at least one diisocyanate with at least one hydroxy-capped perfluoropolyether and at least one polyol having a functionality of at least 2. As mentioned in column 3, line 26 to column 4, line 22 of the '135 patent, the hydroxy-capped perfluoroether is a compound of general formula  $\text{OH-R}_f\text{-OH}$  with a molecular weight of 400 to 7,000 daltons, wherein  $\text{R}_f$  represents a fluorine-containing, unbranched or branched organic residue. The polyol used for the production of the fluorinated polyurethane can be a higher molecular polyol having a molecular weight of  $> 500$  daltons, whereby, as specific examples, inter alia, polyethyleneglycol 1000, polytetramethyleneglycol and polycaprolactone-diol are mentioned (cf. column 3, lines 12 to 25).

As mentioned in column 4, lines 23 to 32 of the '135 patent, the fluorinated polyurethanes described therein show a fluorine content of  $> 30$  wt.-%, which is clearly beyond the claimed range of 1 to 4 wt.-% as set forth in claim 30. The reference cited by the Examiner does not, therefore, anticipate the common inventive feature of the inventions of Groups I to III which is seen in the provision of a fluorine-modified polyurethane resin having a polymerbonded fluorine content of 1 to 4 wt.-% in the system as a whole.

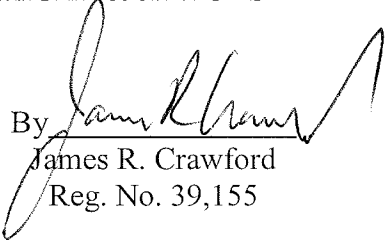
The requested election of a single species, is also traversed. In fact, species II and III, which are mentioned in claims 31 and 33 of the present application, are educts, respectively, for the production of the fluorine-modified macromonomer of species I. Since the use of the educts leads to the manufacture of the product, a common inventive concept is present.

In view of the foregoing, reconsideration of this requirement is respectfully requested.

The Commissioner is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 50-0624, under Order No. NY-HUBR-1288-US. A duplicate copy of this paper is enclosed.

Respectfully submitted

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